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10/598,223

08/22/2006

Herbert E. Schwartz

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EXAMINER

LEVINE, JOSHUA H

ART UNIT

PAPER NUMBER

3774

MAIL DATE

DELIVERY MODE

11/12/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

| | | | |
|------------------------------|--------------------------------------|---|--|
| Office Action Summary | Application No. 10/598,223 | Applicant(s) SCHWARTZ, HERBERT E. | |
| | Examiner JOSHUA LEVINE | Art Unit 4177 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 September 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 11-50 is/are pending in the application.
- 4a) Of the above claim(s) 11-34 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 35-50 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 August 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>08/22/2006</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

This office action is responsive to the species election filed on 09/22/2008. As directed by the amendment: no claims have been amended, no claims have been cancelled, and no new claims have been added. Claims 11-35 have been withdrawn from consideration as not being relevant to the elected species; the election was made without traverse. Thus, claims 1-50 are presently pending in this application.

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Regarding claim 40-41, the phrase "such as" when referring to the cartilage replacement material renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. See MPEP § 2173.05(d).
3. Claim 44 is rejected as a repeated claim being an exact replicate of claim 43.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 35-38, 43-46 and 48-50 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hayhurst (5647874) in further view Fallin et al. (6972027).

6. Regarding claims 35-38, Hayhurst disclosed all the elements of the claim including, a section of cartilage replacement material 98 (figure 17), a biocompatible flexible member 118 (figure 19), a biocompatible anchor 110 (figure 19) connected to an end of said flexible member, said anchor shaped to seat into tissue at the defect site to retain said section of cartilage replacement material at the defect site as shown in figure 17, said biocompatible flexible member traversing through said section of cartilage replacement material multiple times (column 10 lines 18-21), said flexible member attached to said section of replacement material at an attachment point 68 (figure 17), except for the flexible member threaded twice through the anchor. Fallin teaches an anchor 56 (figure 7) with a flexible member 60 (figure 7) threaded through said anchor at least twice to form at least two loops as shown in figure 7. The loop one starts at passageway 68A (figure 7) and ends at passageway 68B (figure 7). The second loop is between passageways 68B and passageway 68C. The opposite end 84 (figure 7) of said flexible member is looped around said flexible member 60 to form a sliding device 88 (figure 7) for adjusting said distance between attachment point 58 (figure 7) and said anchor. The sliding device is a slipknot. A slipknot is a knot that can easily be made tighter or looser by pulling one of its ends (Cambridge Advanced Learners Dictionary). Knot 88 can be made looser by pulling at one of its ends by line 95/97 (figure 7, column 8 lines 35-41). Therefore, It would have been obvious to one of ordinary skill in the art at the time of the invention to include the two loops and the knots, as suggested and taught by Fallin, for the purpose of creating loops and knots that allow slack in the flexible member for easy placement of the anchors as well as a mechanism to retract

the slack in order to sufficiently tightly close tears to ensure proper healing (column 8 lines 28-323, column 8 lines 38-41).

7. Regarding claim 43-45 and 48-50, Fallin teaches a flexible member that further includes a stopping member 88 (figure 15 column 6 lines 41-48), said stopping member engageable with said section of cartilage replacement material where the stopping member is a slipknot. It would be obvious to one of ordinary skill in the art at the time of the invention to include the stopping member in order to create a device that allows for a sufficiently tight closure of the cartilage replacement material to the bone to ensure proper healing.

8. Regarding claim 46, Hayhurst disclosed all the elements of the claim including at least one biocompatible anchor 110 (figure 19) shaped to seat into tissue at the defect site to retain said section at the defect site, and a biocompatible flexible member 118 (figure 19) having first and second ends 120 (figure 19), said first end 120 of said flexible member attachable to the section of cartilage replacement material at an attachment point 68 (figure 17), except for loops formed around the anchor. Fallin teaches said second end of said flexible member threaded through said anchor at least twice to form at least two loops as shown in figure 7, and looped around said flexible member to form a sliding device 88 (figure 7) with a distance between the attachment point (58 figure 7). Therefore, It would have been obvious to one of ordinary skill in the art at the time of the invention to include the two loops, as suggested and taught by Fallin, for the purpose of creating loops that allow slack in the flexible member for easy placement of the anchors as well as a mechanism to retract the slack in order to

Art Unit: 4177

sufficiently tightly close tears to ensure proper healing (column 8 lines 28-323, column 8 lines 38-41).

9. Claims 39-41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hayhurst (5647874) in further view Fallin et al. (6972027) in further view of Binette et al (PG Pub no. 20050113937). Binette teaches a section of cartilage replacement material that is formed at least in part of a material selected from the group consisting of non-woven materials and foam materials including polyvinyl alcohol, polyethylene oxide, saccharides and polysaccharides (claim 12). It would be obvious to one of ordinary skill in the art at the time of the invention to include these materials, as suggested and taught by Binette, for the purpose of facilitating cohesion of tissue fragments to allow an implant to take a semi-solid form allowing it to be cured into a solid implant.

10. Claims 42 and 47 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hayhurst (5647874) in further view Fallin et al. (6972027) in further view of Wolf et al (PG Pub no. 20040267314). Wolf teaches flexible members that are braided sutures (paragraph 22). It would have been obvious to one of ordinary skill in the art at the time of the invention to include the braided sutures, as suggested and taught by Wolf, for the purpose of allowing more flexibility to maneuver in surgical applications while adding tensile strength to the suture (paragraph 22).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JOSHUA LEVINE whose telephone number is (571)270-

Art Unit: 4177

5413. The examiner can normally be reached on Monday-Thursday 7:30am-5:00pm
ETA.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Isabella can be reached on 571-272-4749. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/JOSHUA LEVINE/

Examiner, Art Unit 4177

/Paul B. Prebilio/

Primary Examiner, Art Unit 3774

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